



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/330,792	06/11/1999	EDWARD B. KNUDSON	UV-56	9835

7590

04/26/2004

G VICTOR TREYZ
FISH & NEAVE
1251 AVENUE OF THE AMERICAS
NEW YORK, NY 100201104

EXAMINER

BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/330,792

Applicant(s)

KNUDSON, ET AL

Examiner

Reuben M. Brown

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-61, 63, 65-85, 127-144, 146, 148-168, 210-228, 230, 232-252 & 255-294 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 43-61,63,65-85,127-144,146,148-168,210-228,230,232-252 and 255-294.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 43-44, 46-61, 63, 65-77, 127-128, 130-160, 210-211, 213-228, 230, 232-244, 255-256, 258-271 & 275-286 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young, (U.S. Pat # 4,706,121), in view of Russo, (U.S. Pat # 5,619,247)

Considering claims 43, 127, 210 & 255, the amended claimed interactive TV program guide system and method for displaying TV programs, in which TV programs are displayed on a user's TV equipment comprising a means for storing program listings for a plurality of channel

Art Unit: 2611

sand time slots is met by Young col. 9, lines 50-55 & col. 12, lines 12-18. As for the amended claimed means for allowing a user to schedule a recording of a subset of the series, such that the subset includes a plurality of TV programs selected from the series, Young teaches a user at least making at least weekly or daily recording of TV programming.

However, Russo teaches a system that may automatically record programs based upon a subscriber's preferences; see Abstract; col. 3, lines 11-15 & col. 5, lines 48-65. This disclosure teaches selectively recording programs based upon a combination of criteria, as recited in the claims. It would have obvious for one of ordinary skill in the art at the time the invention was made, to modify Young with the known technique of recording programs (for instance from a series of programs) based upon a customer's preferences or criteria for the known advantage of a more user friendly system that assists the user in deciding which programs would most likely be of interest.

Considering claims 44, 128, 211 & 256, Young is directed to recording using user equipment.

Considering claims 46-48, 130-132, 213-215 & 258-259, the EPG in Young is at least partially stored on a server, since it is transmitted from a server to subscriber. Furthermore Young teaches a user selecting TV programs for record/timer, col. 15, lines 21-40.

Art Unit: 2611

Considering claims 49-53, 133-136, 216-220 & 260-265, Young teaches a plurality of record options for selecting episode or series of TV programs, col. 15, lines 20-40; col. 15, lines 60-67 & col. 16, lines 1-15.

Considering claims 54, 137, 121 & 266, Young also teaches reminder option, col. 15, lines 20-27.

Considering claims 55, 138, 222 & 267, Young enables a user to record a single episode in a TV series, col. 15, lines 28-30.

Considering claims 56-59, 139-142, 223-226 & 268-271, the claimed subject matter reads on the option in Young of recording all programs in TV series.

Considering claims 66-73, 75, 149-156, 158, 233-240 & 242, 275-282 & 284, Young teaches that the user is enabled to update the list of programs to be selected for recording, wherein the list is displayed fro the user, col. 16, lines 18-38.

Considering claims 74, 76-77, 157, 159-160, 241, 243-244, 283 & 285-286 Young teaches that the scheduled recordings, episodes and/or series of TV programs may be deleted in the system, col. 15,lines 41-42 & col. 16, lines 28-37.

Art Unit: 2611

4. Claims 45, 129, 212 & 257 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young & Russo, in view of Lawler, (U.S. Pat # 5,805,763).

Considering claims 45, 129, 212 & 257, Young does not teach recording at a server. However, Lawler teaches that a user optionally enabled to instruct a recording device at a head-end server to store a selected program, col. 10, lines 56-59. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Young with the feature of recording programs at a head-end server, as taught by Lawler, at least for the desirable advantage of preserving storage capacity at the user equipment.

5. Claims 60-61, 63, 65, 143-144, 148, 227-228, 230, 232 & 272-274 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young & Russo, in view of Schindler, (U.S. Pat # 5,995,155).

Considering claims 60-61, 63, 65, 143-144, 148, 227-228, 230, 232 & 272-274, Young & Russo do not explicitly teach such a feature, even though Russo discloses recording based upon user preferences. Nevertheless, the claimed subject matter reads on the disclosure of Schindler recording first-run status programs, col. 4, lines 15-25. As for the feature of recording rerun programs, this feature is necessarily included in the operation of Young, which records all programs in the series. It would have been obvious for one of ordinary skill in the art at the time

Art Unit: 2611

the invention was made, to modify Young with the teachings of Schindler recording only first-run programs, for the desirable benefit of avoiding the user having to delete duplicate programs.

6. Claims 78-85, 161-168, 245-252 & 287-292 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young & Russo, in view of Marsh, (U.S. Pat # 6,208,799).

Considering claims 78-85, 161-168 & 245-252, Young does not discuss the well-known problem of resolution of time conflicts, among reserved programs. However, Marsh discloses the known problem and solutions of the timing conflicts, Abstract & col. 11, lines 1-40. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Young with the teachings of Marsh resolving timing conflicts, at least for the desirable improvement of providing the subscriber with a more efficient recording process,

Regarding claims 84, 162, 167, 246 & 251, Official Notice is taken that at the time the invention was made, the simultaneous watch & record feature was known. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Young, Russo & Marsh, not displaying conflicts when at least one program can be watched while the other is recorded, at least for the known purpose of avoiding concerning the subscriber unnecessarily with issues that can be resolved electronically.

Art Unit: 2611

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2611

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 746-6861 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")


*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington,
VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399.
The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the
organization where this application or proceeding is assigned is (703) 872-9306 for regular
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown


VIVEK SRIVASTAVA
PRIMARY EXAMINER